

Remarks

Reconsideration of this Application is respectfully requested.

Status of the Application and Claims

The present Amendment and Reply is being filed together with a Request for Continued Examination (RCE) under 37 C.F.R. § 1.114, and is in response to a first/final Office Action on the merits of the claims following the Decision on Appeal issued March 27, 2007, in the subject application. Applicants are in receipt of an Advisory Action mailed June 25, 2009, refusing entry of an Amendment and Reply under 37 C.F.R. § 1.116 filed April 29, 2009. The present Amendment and Reply is submitted in lieu of the Amendment and Reply filed April 29, 2009, re-presents certain arguments and remarks of the Amendment and Reply filed April 29, 2009, and presents additional new claims for consideration.

Upon entry of the foregoing amendments, claims 1-13, 23-27, and 29-53 are pending in the application, with claims 1, 6, 7, 9-13, 23, 26, 27, and 29 being the independent claims. Claims 14-22, previously withdrawn from consideration in the present application pursuant to a Restriction Requirement, are cancelled herein without prejudice to, or disclaimer of, the subject matter recited therein. Independent claim 28 also is cancelled herein without prejudice to, or disclaimer of, the subject matter recited therein. Claims 1-13, 23-27, and 29 are amended herein. Claims 30-53 are newly presented herein. No new matter has been added.

Summary of the February 5, 2009 Office Action

In the Office Action, the prior Restriction Requirement was made final, claims 12, 13, 28, and 29 were identified by the Examiner as containing language allegedly not mentioned in the specification (hereafter "objected to"), such that there allegedly is insufficient

Atty. Docket: 3222.1320001

antecedent basis for the language in the claims, and claims 1-13 and 23-29 were rejected under 35 U.S.C. § 112, 1st paragraph, as allegedly failing to comply with the written description requirement.

Reconsideration and withdrawal of the "objection" and rejection respectfully are requested in view of the above amendments and the following remarks.

Summary of Examiner Interviews

Applicants' attorneys gratefully acknowledge the courtesies extended to them by the Examiner in granting telephone interviews on March 23, 2009, June 17, 2009, and July 2, 2009.

In the March 23, 2009 interview, Applicants' attorneys requested clarification of the objection and rejection set forth in the Office Action. With respect to the "objection" to certain language in claims 12, 13, 28, and 29, the Examiner stated that the claims were not formally rejected on this stated basis. In this regard, Applicants' attorneys noted, and the Examiner acknowledged, that claims 12 and 13 do not include any of the language listed in the Examiner's objection; accordingly, the Examiner withdrew the objection with respect to these claims. Applicants' attorneys also asserted, and the Examiner acknowledged, that the language "means for" presented in accordance with proper means-plus-function format under the sixth paragraph of 35 U.S.C. § 112 corresponds to the particular structure(s) disclosed in the specification that performs the claimed function(s), and equivalents of such structure(s), and that the language "means for" is not required to be present in the specification for such language to be supported in such claim(s); in response to the discussion, the Examiner withdrew the objection with respect to the listed "means for ..." terms. Applicants' attorneys also proposed for discussion a number of exemplary amendments to the specification,

including language supported *in haec verba* in the original specification (including the original claims) of original parent Application No. 09/337,035 (incorporated by reference in the present application, and now U.S. Patent No. 6,671,718), and amendments to the claims deleting certain language objected to by the Examiner also in favor of language supported *in haec verba* in the specification (including the original claims) of original parent Application No. 09/337,035, to obviate the objection and the rejection set forth in the Office Action. The Examiner stated that if the proposed amendments conform to the subject matter presented in the claims originally filed in the 09/337,035 application, and if the remarks in reply to the Office Action reference that the descriptive passages to be added to the present specification are supported in the original 09/337,035 application (including the original claims), then the Examiner would be inclined enter the amendments to the specification.

In a first telephone interview on June 17, 2009, Applicants' attorney inquired of the status of the application and Amendment and Reply filed April 29, 2009, noting that Applicants had requested withdrawal of the finality of the Office Action in the Amendment and Reply, and that the Patent Office electronic docketing system PAIR indicated that the Office Action mailed February 5, 2009 is a non-final office action. The Examiner confirmed this status and stated that the application and Amendment filed April 29th were on his docket for further examination.

In a follow up telephone interview on June 17th, the Examiner advised Applicants' attorney that he had spoken with his supervisory examiner, that the Patent Office electronic docketing system PAIR was in error, that the Office Action mailed February 5, 2009 was a final office action, that the Patent Office docketing clerks had been instructed to correct that

error, that the Amendment and Reply filed April 29, 2009 would not be entered, and that an Advisory Action setting forth the reasons for such was being mailed to Applicants' attorney.

In a telephone interview on July 2, 2009, Applicants' attorney requested clarification of the Advisory Action mailed June 25, 2009, which indicates refusal to enter the Amendment filed April 29, 2009, because, *inter alia*, the proposed amendments "raise the issue of new matter." The Examiner stated that this was an error, and that the reason for refusal was (only) because the amendments "raise new issues that would require further consideration and/or search."

Amendments to the Specification

Applicants respectfully request that the specification be amended to include subject matter explicitly recited in the original specification (including the original claims) of original parent Application No. 09/337,035 (previously incorporated herein by reference in the present application, and now U.S. Patent No. 6,671,718), as discussed in the Examiner interview. The amendments to the specification include the same subject matter, using substantially the same language, as recited in original claims 1/6, 13, 14 and 22, as discussed below. Portions of these original claims particularly relied upon for various amendments to the currently pending claims are emphasized by italics and/or highlighting (see discussion below). No new matter has been added.

Paragraph [0016.1] recites subject matter substantially the same as original claim 6, which depends from original claim 1.

1. (Original Parent Application Claim) An e-mail method, comprising:
recognizing whether an electronic mail message is to be sent; and
alerting a system user as to the message being sent.

6. (Original Parent Application Claim) A method as recited in claim 1, ***wherein said recognizing recognizes a send operation initiated by an unauthorized agent.***

Paragraph [0016.2] recites subject matter substantially the same as original claim 13.

13. (Original Parent Application Claim) An electronic mail method, comprising:
recognizing that a message is to be sent by an unauthorized agent; and
alerting the user.

Paragraph [0016.3] recites subject matter substantially the same as original claim 14.

14. (Original Parent Application Claim) An e-mail method, comprising:
recognizing whether an electronic mail message is to be sent by a user or an unauthorized agent;
alerting the user as to the message being sent and as to addressees of the message by providing a display of both alias names and fully resolved addresses when available and a confirmation field for each address;
allowing the user to approve sending of the message to an addressee after the alert by marking the confirmation field;
allowing the user to modify an addressee list after the alert;
allowing the user to erase the message; and
sending the message after all addressees have been approved.

Paragraph [0016.4] recites substantially the same subject matter of original claim 22.

22. (Original Parent Application Claim) An electronic mail method, comprising:
determining whether an electronic mail message is to be sent by detecting a send operation initiated by the user ***or detecting a send operation initiated by an unauthorized agent;***
alerting an e-mail system user as to addressees of the message by providing a display of both available alias names and fully resolved addresses and a confirmation field for each intended recipient;

allowing the user to modify an addressee list after the alert with the alert being again produced after the intended recipient list is modified;

allowing the user to approve sending of the message after the alert; and
sending the message after approval.

Favorable consideration and entry of these formal amendments to the specification respectfully are requested.

Objection to Claim 12, 13, 28, 29 and Certain Claim Language Traversed

The "objection" to claims 12, 13, 28, and 29, and to certain language allegedly recited in such claims, respectfully is traversed.

Initially, as agreed to by the Examiner in the telephone interview on March 23, 2009, claims 12 and 13 do not include any of the listed terms, and the language "means for ..." presented in the claims (means-plus-function format under paragraph 6 of 35 U.S.C. § 112) does not require *in haec verba* antecedent basis in the specification.

With respect to the remaining terms, Applicants submit that use of such terms in the claims is supported by the disclosure in the original application. Applicants direct the Examiner's attention to the written disclosure at page 5, lines 9-13 of the original application, wherein Applicants disclose exemplary features of a system implementing the claimed invention. Specifically, the specification states (emphasis added):

The present invention is designed to operate in an environment in which a user of an electronic mail (e-mail) system has access to a typical computer system, as depicted in Figure 1, such as a desk top *computer system including a computer which executes an e-mail client application . . . The computer also includes storage, including RAM, ROM, magnetic disk, optical disk, etc., suitable for storing and distribution of the processes and displays described herein. . .*

Those skilled in the relevant art of computers and electronic mail messaging systems readily will appreciate that such disclosure of a computer system including such *storage* clearly

supports the features and claim language/terms "computer readable storage medium" and "computer-readable medium."

Finally, without conceding the propriety of the objection, claim 28 has been cancelled herein without prejudice to or disclaimer of the subject matter recited therein. Accordingly, the objection to the term "module" is rendered moot.

For the reasons discussed above and in the Examiner interview, reconsideration and withdrawal of the "objection" respectfully are requested.

Rejection Under 35 U.S.C. 112 Traversed

The rejection of claims 1-13, 23-27, and 29 under the first paragraph of 35 U.S.C. § 112, respectfully is traversed. Nevertheless, without conceding the propriety of the rejection, the specification has been amended herein to include subject matter presented in the original claims of original/parent Application No. 09/337,035 (now U.S. Patent No. 6,671,718), which application was incorporated by reference in the present application upon filing of the present application; further, without conceding the propriety of the rejection, claims 1-13, 23-27, and 29 have been amended herein to delete language therein objected to by the Examiner in favor of language more clearly provided in the application as originally filed and/or as amended above to explicitly include the subject matter of original parent Application No. 09/337,035 previously incorporated by reference. No new matter has been added.

Applicants submit that claims 1-13, 23-27, and 29 satisfy all of the requirements of 35 U.S.C. § 112. Support for each of the independent claims may be found throughout the specification, and particularly in Fig. 1 and paragraphs [0010], [0011], [0014], [0016.1]-[0016.4], [0017], and [0024]-[0026], as discussed below (emphasis added by italics and highlighting).

Initially, the specification explicitly teaches that the inventors well knew that a computer virus is a process executing on a user's computer system that can compose and send/transmit an unauthorized e-mail. The specification also explicitly states that an object/feature of the invention is to provide a system that alerts a user to the fact that such an unauthorized electronic mail message is about to be sent from a computer by such an unauthorized agent (e.g. a virus), thereby to control a send operation of the unauthorized e-mail, e.g., to stop transmission of the unauthorized mail and to permit the user to erase it. For example, the specification states:

[0010] Today ***computer viruses can compose and send e-mail without a user being aware of the transmission of such unauthorized e-mail.***

[0011] ***What is needed is a system that will alert a user when an unauthorized e-mail is being sent by the user's system and allow the user to cancel the message before it is sent.***

SUMMARY OF THE INVENTION

...

[0014] ***It is another object of the present invention to alert a user when an unauthorized e-mail is being sent.***

...

[0017] ***These together with other objects and advantages which will be subsequently apparent, reside in the details of construction and operation as more fully hereinafter described and claimed,*** reference being had to the accompanying drawings forming a part hereof, wherein like numerals refer to like parts throughout.

As disclosed in the above paragraphs, the specification defines an email composed by a computer virus as an unauthorized e-mail, and explicitly identifies as an object and feature of the invention to provide an alert when such an unauthorized e-mail, e.g., an e-mail composed by a computer virus (i.e., a *process* executing on the user's system), is about to be sent from the computer.

The subject matter recited in original claims 1/6, 13, 14 and 22 of original parent Application No. 09/337,035, added by formal amendment to the specification herein as paragraphs [0016.1]-[0016.4], further explains features of such an unauthorized e-mail message composed and sent by an unauthorized agent, such as a virus / process executing on the user's computer.

[0016.1] In one aspect, the present application relates to an e-mail method comprising **recognizing whether an electronic mail message is to be sent** and alerting a system user as to the message being sent, **wherein the recognizing process recognizes a send operation initiated by an unauthorized agent**.

[0016.2] In another aspect, the present application relates to an electronic mail method comprising **recognizing that a message is to be sent by an unauthorized agent**, and alerting the user.

[0016.3] In another aspect, the present application relates to an e-mail method comprising **recognizing whether an electronic mail message is to be sent by a user or an unauthorized agent**, and alerting the user as to the message being sent. The method may include alerting the user as to addressees of the message by providing a display of both alias names and fully resolved addresses when available, and a confirmation field for each address, allowing the user to approve sending of the message to an addressee after the alert by marking the confirmation field, allowing the user to modify an addressee list after the alert, **allowing the user to erase the message**, or sending the message after all addressees have been approved.

[0016.4] In another aspect, the present application relates to an electronic mail method comprising **determining whether an electronic mail message is to be sent by** detecting a send operation initiated by the user or **detecting a send operation initiated by an unauthorized agent**, and alerting an e-mail system user as to addressees of the message by providing a display of both available alias names and fully resolved addresses and a confirmation field for each intended recipient. The method further may include allowing the user to modify an addressee list after the alert with the alert being again produced after the intended recipient list is modified, allowing the user to approve sending of the message after the alert, or sending the message after approval.

The specification provides further disclosure tying these features together and evidencing that the inventors had possession of the subject matter recited in the claims at the

time the application was filed. And the specification describes structure for carrying out the claimed invention.

[0024] **The present invention** is directed to a system that includes an electronic mail (e-mail) alert system which reduces the possibility of inadvertently sending an e-mail message to an unintended recipient and **allows the user to intercept and stop unauthorized e-mail from being sent by the user's computer**. The present invention modifies the operation of a conventional e-mail system (or computer-user to computer user or other network communication device to computer-user messaging system or other network communication device) to **alert the user before messages are sent and allow the user to change the recipients or cancel the message**.

[0025] The present invention is designed to operate in an environment in which a user of an electronic mail (e-mail) system has access to a typical computer system 10, **as depicted in Figure 1, such as a computer system including a computer 12 which executes an e-mail client application**, a display 14 on which e-mail messages are viewed in application windows, a keyboard 16 used to compose e-mail messages and an input device 18, such as a mouse, used to activate controls (buttons) in the e-mail system. The computer 12 includes a modem or network interface that allows the computer to connect to a transmission network 20, such as a corporate or enterprise network, the Internet or any other computer or communications network, allowing the user to send messages to and receive messages from other computers 22 and 24 (or other network communications devices) connected to the network. The computer also includes **storage, such as RAM, ROM, magnetic disk, optical disk, etc., suitable for storing and distribution of the processes and displays described herein**. The invention can also be distributed via downloading over a network or otherwise.

[0026] **When** a user has composed a message and requested that the message be sent) for example, by activating a send control -button - on the e-mail application's graphical user interface (GUI) displayed on the display 14 by the e-mail program executing in the computer 12), or **an unauthorized message is about to be sent, the present invention alerts the user by popping-up or displaying a dialog box 30, such as depicted in Figure 2, or activating another type of alert** such as an icon, sound, verbal cue, etc. The alert need not be limited to the type shown in Figure 2, which is offered an [sic] example only. The dialog box 30 includes text 32 which indicates to the user that the user is about to send a message to the listed individuals.

Thus, each of independent claims 1, 6, 7, 9, 10, 11, 12, 13, 23, 26, 27, and 29 recites subject matter that is described in the specification in a manner such that those skilled in the

art readily would appreciate that the inventors had possession of the claimed subject matter at the time the application was filed.

Claims 30-53

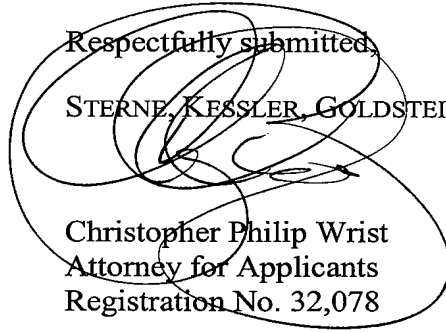
Newly presented claims 30-53 depend directly or indirectly from independent claims 1, 6, 7, 9, 10, 11, 23, 26, and 29, and have been added to provide Applicants with additional scope of coverage commensurate with the disclosure. Support for claims 30-53 may be found throughout the application, e.g., in the prior pending claims and the quoted portions of the application set forth and discussed above. No new matter has been added.

Favorable consideration of new dependent claims 30-53 respectfully is requested.

Conclusion

Applicants believe that the present Amendment and Reply is responsive to each of the points raised by the Examiner in the Final Office Action, the Advisory Action, and the various telephone interviews, and submit that the application and claims are in condition for allowance. Favorable consideration of the claims and passage to issue of the application at the Examiner's earliest convenience earnestly are solicited.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Respectfully submitted,
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Date: July 6, 2009

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